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EXAMINER
NGUYEN, MAIKHANH

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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10-25,27-39 and 41-47* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10-25,27-39 and 41-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: RCE filed 12/22/2006 to the original

application filed 05/20/1999.

Claims 1-8, 10-25, 27-39, and 41-47 are presented for examination. Claims 1, 17, and

30 have been amended. Claims 9, 26, and 40 have been cancelled. Claims 1, 17, and 30

are independent claims.

Request Continuation for Examination

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR

1.17(e) has been timely paid, the finality of the previous Office action has been

withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/22/2006 has

been entered.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 30-39 and 41-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 30, the claim recites *a system* in the preamble only, the body of the claim merely contains software components. The claim is a program per se and is not embodied in a computer readable storage medium. Therefore, the cited system is not a "system" and is not statutory subject matter.

Dependent claims 31-39 and 41-47 and are rejected for fully incorporating the deficiencies of their base claims.

Claims which are broad enough to read on statutory subject matter or on non-statutory subject matter are considered non-statutory. Cf. In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972) ("Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject

matter."). During prosecution, applicant can amend to limit the claims to statutory subject matter.

See MPEP 2107 for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

Claim Rejections - 35 USC § 103

4   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7, 10-19, 21-25, 27-39, and 41-47 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Emmelmann** (US 2003/0074634, filed 11/1999) in view of **Pacifici et al.** US 6230171, filed 08/1998).

As to claim 17:

Emmelmann teaches a computer-implemented method of providing dynamic effects to an HTML document *(see Abstract and the discussion beginning at ¶0025)*, comprising the steps of:

- encapsulating code in an external component that is external to the document may affect a behavior of one or more elements contained in the document, including

elements of different documents *(e.g., interactive server side components 'ISSC'*

...encapsulate dynamic page functions ... ISSC's can be reused on dynamic pages

and the number and the kinds of ISSC contained on a single page can change

dynamic during page generation ... It generates HTML code ... The ISSC

algorithm makes sure that all components work without disturbing each other,

even when nested and combined; see ¶¶ 0025-0027);

• inserting an element into the document *(e.g., components can be added to the*

page ... Each component marked on a page has a certain component kind 'the tag

name in HTML terminology ... putting a component tag on the page; see ¶¶

0068- 0073 & components can be nested, i.e., they can contained other

components ... this is expressed by HTML/XML elements with end-tag; see¶

0084);

• attaching a reference in the document to associate the element with an instance of

the external component *(e.g., Component Identification--bid ... a component must*

include the bid into the name of each form control generated. We do that by

adding the bid followed by a point to the name of the form control. When the user

submits a form, the form data set is included in the request as name-value pairs.

Since the name of each form control includes the bid, the ISSC processor can

consult the bid to find out the component instance that contains the form control.

When adding URL parameters to the link of an URL, parameter names must also

be prefixed with the bid; see ¶ ¶ 0106-0108), such that another instance of the

element may be referenced by a different document, and wherein code is not

included in the document *(e.g., a browser based editor that can place ISSC's on*

pages and to modify their properties; see ¶ 0027 /encapsulate information which

is incorporated into the first document; see claim 31);

- providing the document to a render *(e.g., the display method generates browser*

  code, such as HTML, Javascript, XML, or whatever the browser understands, that

  displays the component on the browser screen ... generates a browser page by

  using the component classes... page is passed to the web server (24), which sends

  it to the client browser) [see the discussion beginning at ¶ 0076], wherein the

  render is capable of instantiating the external component, associating an interface

  of the instance of the external component with the element, and displayed the

  rendered document *(e.g., the information is stored in an array 'named comps' of*

  the browser's scripting language. It contains a component description for each

  component instance on the page. The component instance number is used to index

  the array. Each component description is an object of the browser's scripting

  language and contains the following information: the kind of the component; the

  position of the component in the component page; and the attributes of the

  component. This is in turn is a record containing all the attributes given in the tag

  marking the component ... a script must be embedded in the page. The script is

executed by the browser when the page is displayed and it builds up the

component array data structure) [see ¶ 0236].

Emmelmann does not explicitly teach *"the external component is maintained in a*

cascading style sheet."

Pacifici teaches the external component is maintained in a cascading style sheet *[see*

col.6, lines 20-22 & col.9, lines 55-col. 10, line 67 & also see fig. 6 and the associated

text].

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to modify Emmelmann with Pacifici because Pacifici's teaching would have

provided the capability for modifying each reference Web page to include a reference to a

markup agent, realized in the form of a client script, as well as a reference to a stylesheet

(Pacifici; col. 3, lines 55-59).

As to claim 18:

Emmelmann teaches providing the external component to the renderer *(see ¶¶ 0140;*

0142; 0158; and 0161).

As to claim 19:

Emmelmann teaches rendering a page image from the document, accessing the external

component *(see ¶¶ 0123-0124 & also see fig.10 and the associated text)*, and modifying a

representation of the element based on the code in the external component *(see ¶¶ 0027,*

0310, and 0388).

As to claim 21:

Emmelmann teaches the changing the appearance thereof *(see ¶ 0027)*.

As to claim 22:

Emmelmann teaches the changing the location thereof *(see ¶ 0027)*.

As to claim 23:

Emmelmann teaches rendering a page image from the document, accessing the external

component, and drawing information in the image based on the code in the external

component *(see ¶¶ 0073 and 0250)*.

As to claim 24:

Emmelmann teaches rendering a page image from the document is interleaved with

drawing information in the image *(see ¶ 0250)*.

As to claim 25:

Emmelmann teaches receiving an event indicative of user interaction with the image

(e.g., the user presses a link ... Clicking on the button makes the component scroll; see

¶¶ *0098 and 0102).*

As to claim 27:

Emmelmann teaches the information associating the element with the external component

is maintained in a custom tag *(see ¶ 0398).*

As to claim 28:

Emmelmann teaches the information associating the element with the external component

is maintained in a class identifier *(e.g., each interactive component instance gets an*

unique identification called bid. The bid must be unique at least within a session; see ¶

0107).

As to claim 29:

Emmelmann teaches the reference associating the element with the external component is

maintained inline with the element in the document *(see ¶¶ 0075, 0091, and 0094).*

As to claim 1:

The rejection of claim 17 above is incorporated herein in full. Additionally, Emmelmann teaches:

- rendering a page image corresponding to at least part of the document, the page image including a representation of the element *(see ¶¶ 0123-0124; see also fig.10 and the associated text)*; and

- accessing the external component for determining a behavior of the representation of the element rendered on the page image *(see ¶ 0023)*.

It is noted that claim 1 does not require *"displaying the rendered document."*

As to claim 2:

Emmelmann teaches receiving an event, and wherein accessing the external component is performed in response to the event *(see ¶¶ 0076, 0098, and 0102)*.

As to claims 3-5:

Refer to the discussions of claims 21-23, respectively, for rejections.

As to claim 6:

Emmelmann teaches the external component comprises an object *(e.g., component objects; see ¶ 0179)*, and wherein accessing the external component includes instantiating an instance of the object *(e.g. an instance of the component page; see ¶ 0073).*

As to claim 7:

Emmelmann teaches receiving a new document having another element thereon, the new document including information associating the other element with the external component *(see ¶ 0091)*, rendering a new page image corresponding to at least part of the document, the new page image including a representation of the other element *(see ¶¶ 0123-0124; see also fig.10 and the associated text)*, and accessing the external component for determining a behavior of the representation of the other element rendered on the page image *(see ¶0023).*

As to claims 10-12:

Refer to the discussions of claims 27-29, respectively, for rejections.

As to claim 13:

Emmelmann teaches the document includes another element having a representation thereof rendered in the page image, the document includes other information associating the other element with the external component *(see ¶ 0123-0124; see also fig.10 and the*

associated text), and further comprising, accessing the external component for

determining a behavior of the representation of the other element *(see ¶ 0023)*.

As to claim 14:

Emmelmann teaches the document includes information associating the element with a

second external component *(see ¶ 0091)*, and further comprising, accessing the second

external component for determining a behavior of the representation of the element *(see*

¶ 0023).

As to claim 15:

Emmelmann teaches resolving a conflict between the behavior determined by the

external component and the behavior determined by the second external component *(see*

¶¶ 0094, 0174, 0179-0180, and 0396-0397).

As to claim 16:

Emmelmann teaches downloading the external component *(e.g., the components are*

downloaded from the server; see ¶ 0013).

As to claim 30:

The rejection of claim 17 above is incorporated herein in full. Additionally, Emmelmann

teaches modifying the behavior of elements, including elements of different documents

(e.g., editing of the component's attributes ... to insert, move, copy, or delete

components; see ¶ 0027).

As to claim 31:

Refer to the discussion of claim 25 above for rejection.

As to claim 32:

Emmelmann teaches the renderer displays a representation of the element and modifies a

behavior of the element by accessing the external component *(see ¶¶ 0027, 0310, and*

0388).

As to claims 33-35:

Refer to the discussions of claims 21-23, respectively, for rejections.

As to claim 36:

Emmelmann teaches the renderer calls the external component a plurality of times to

draw information on the page image, and the renderer draws information on the page

image between at least some of calls to the external component *(see ¶0250, 0087-0091,*

and 0138).

As to claim 37:

Refer to the discussion of claim 6 above for rejection.

As to claim 38:

Emmelmann teaches the external component comprises an object *(e.g., component objects; see ¶ 0179)*, and wherein the rendered communicates with the object *(see ¶ 0243)*.

As to claim 39:

Emmelmann teaches the render receives a new document having another element thereon that references the external component *(e.g., create a new component object, but an existing one can be reused instead ... components can have a name parameter. Fig. 35 illustrates a modified version of the display method of fig. 11; see ¶ 0180)*.

As to claim 41:

Emmelmann does not explicitly teach *"the cascading style sheet is embedded in the document."*

Pacifici teaches the cascading style sheet is embedded in the document *(e.g., dynamic HTML ... using a Cascading Style Sheet; col.9, line 47-col.10, line 7)*.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Emmelmann with Pacifici because Pacifici's teaching would have provided the capability for modifying each reference Web page to include a reference to a

markup agent, realized in the form of a client script, as well as a reference to a stylesheet
(Pacifici; col. 3, lines 55-59).

As to claim 42:

Emmelmann does not explicitly teach "*the cascading style sheet is linked to the*
document."

Pacifici teaches the cascading style sheet is linked to the document *(col.6, lines 1-29).*

It would have been obvious to one of ordinary skill in the art at the time of the invention
was made to modify Emmelmann with Pacifici because Pacifici's teaching would have
provided the capability for modifying each reference Web page to include a reference to a
markup agent, realized in the form of a client script, as well as a reference to a stylesheet
(Pacifici; col. 3, lines 55-59).

As to claims 43 and 44-46:

Refer to the discussions of claims 27 and 12-14, respectively, for rejections.

As to claim 47:

Emmelmann teaches the renderer accesses the external component to control the format
of data input by a user *(see ¶¶ 0102 and 0108; see also fig. 26).*

5.   Claims 8 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Emmelmann** in view of **Pacifici et al.** as applied to claims 1 and 17 above and further in view of **Kindel,** "COM: What Makes it Work", 1997, pp. 68-77.

As to claim 8:

The combination of Emmelmann with Pacifici does not specifically teach the use of COM object.

Kindel teaches the use of COM object *(e.g., see the COM discussion at page 68)*.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Kindel's teaching with Emmelmann as modified by Pacifici because it would have provided the capability for putting the concept of a binary component in the programmer's face by focusing on binary interoperability through interfaces.

As to claim 20:

Refer to the discussions of claim 8 above for rejection.

Response to Arguments

6.   Applicant's arguments filed 12/22/2006 have been fully considered but they are not

persuasive.

a.   Applicant argues in substance that *Emmelmann does not teach attaching a*

reference in the document to associate the element with an instance of the

external component [Remarks, page 13].

In response, the Examiner respectfully submits that Emmelmann's teaching

"Component Identification--bid ... a component must include the bid into the

name of each form control generated. We do that by adding the bid followed by a

point to the name of the form control. When the user submits a form, the form

data set is included in the request as name-value pairs. Since the name of each

form control includes the bid, the ISSC processor can consult the bid to find out

the component instance that contains the form control. When adding URL

parameters to the link of an URL, parameter names must also be prefixed with the

bid" (see ¶ ¶ 0106-0108) meets the claimed *"attaching a reference in the*

document to associate the element with an instance of the external component".

b.   Applicant further argues that *there is no motivation to include the feature from Pacific in the system of the Emmelmann* [Remarks, page 16].

In response, the examiner respectfully submits that the examiner cannot simply reach conclusions based on the examiner's own understanding or experience – or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner point to some concrete evidence in the record in support of these findings. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for the relevance of a cited combination of references is: "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ2d at 1888. Subject matter is unpatentable under section 103 if it would have been obvious ... to a person having ordinary skill in the art. While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination: *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)." Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know,

and the use of that teaching to solve the same [or] similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979). "In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference." *In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992).

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ferrel et al.   US Patent No. 5,860,073   Issued: Jun. 12, 1999

- Lowery et al.   US Patent No. 5,894,554   Issued: Apr. 13, 1999

- Stone et al.   US Patent No. 6,504,554   Issued: Jan. 7, 2003

- Drucker et al.   US Patent No. 6,829,569   Issued: Dec. 7, 2004

- F. Vitali et al., "*Extending HTML in a principled way with displets*", Computer Networks and ISDN System, 1997, pp. 1115-1128.

Contact information

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-

4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30

pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is

571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application
Information Retrieval (PAIR) system. Status information for published applications may be
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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
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Maikhanh Nguyen

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